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OFFICE OF PETITIONS

In re Application of :
Lee et al. :
Application No. 09/401,132 : DECISION ON PETITION
Filed: September 22, 1999 :
Attorney Docket No. SAR-12598A :
(MTKI-04-332A) :

This is a decision on the petition under 37 CFR 1.183, filed February 28, 2005, requesting waiver of the requirements of 37 CFR 1.97(d) so that the Information Disclosure Statement (IDS) filed concurrently may be considered and entered by the examiner.

Applicant requests waiver of the rule based on the following facts:

1. On November 15, 2004, an Office Communication was issued by the European Patent Office in European Patent Application No. 98 934 312.4, corresponding to the above-identified U.S. application. . . .

2. On January 28, 2004, files for both the above-identified U.S. application and the corresponding European Patent Application No. 98 934 312.4 were received in the undersigned's [Andrew D. Fortney's] office. . . .

3. The two files in paragraph 3 were transferred to the undersigned's office as part of an overall transfer of 13 standard banker's boxes of files for various U.S. and foreign patents and patent applications. . . .

4. Between January 28, 2005, and February 2, 2005, the transferred files were inventoried by the

undersigned's office. Beginning on or around February 4, 2005, matters in these transferred files were diligently addressed in due date order.

5. On February 14, 2005, I reviewed the transferred file corresponding to European Patent Application No. 98 934 312.4. I discovered that I did not have copies of the references cited in the Office Communications therein. . .

6. On February 18, 2005, I received copies of copies of the references cited in the Office Communication in European Patent Application No. 98 934 312.4. . . .

7. On February 22-23, 2004, during a detailed review of the Office Communication in European Patent Application No. 98 934 312.4, the references cited therein, and the file for the above-identified U.S. application, I discovered that references D1, D3 and D4 cited in said Office communication had not been cited in the above-identified U.S. application.

Petition dated February 28, 2005, pp. 1-2.

Applicant submitted the above-noted IDS subsequent to the mailing of the final Office action on July 2, 2003. Accordingly, for the Office to consider the IDS, applicant must satisfy the requirements of 37 CFR 1.97(d)(1)-(2). Applicant is required to submit a statement as specified in 37 CFR 1.97(e) and the fee set forth in § 1.17(q). As indicated above, by the time applicant's representative discovered that references D1, D3 and D4 cited in the Office communication had not been cited in the above-identified U.S. application, the time for making the statement required by 37 CFR 1.97(d)(1) had expired, such that the necessary statement could not accompany the IDS in question.

The regulations pertaining to the submission of an IDS do not require that an IDS be filed, but rather, set forth the conditions under which the Office will consider information promptly brought to its attention by an applicant. Further, these conditions are linked to the stage of prosecution at the time of the submission of the IDS, as it is necessary for the Office to balance its need to consider all information relevant to an application with its desire for an efficient operation, as well as its capability to consider information at various stages in the prosecution of an application.

The Office will grant a petition under 37 CFR 1.183, where an applicant demonstrates that an extraordinary situation exists such that justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). The Office acknowledges applicant's representative's candor and his office's preoccupation with the volume of transferred files; however, he has not demonstrated that the delay in the submission of the IDS was caused by "extraordinary circumstances" such that "justice requires" waiver of the requirement for certification set forth in 37 CFR 1.97(d)(1).

Applicant's representative's explanation and the circumstances surrounding the delay in filing the IDS and bringing it to the attention of the Office, are not such that the three month time period of 37 CFR 1.97(e)(1) should be waived. Applicant has not demonstrated that the delay in the submission of the IDS was caused by circumstances beyond applicant's control. The Office notes that equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence. See United States v. Lockheed Petroleum Servs., 709 F.2d 1472, 1475 (Fed. Cir. 1983). Furthermore, where the Office has the power to do so, it should not relax the requirements of established practice to save an applicant from the consequence of his delay. See Ex Parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378, 379 (Comm'r Pat. 1968).

There is no adequate showing of "an extraordinary situation" in which "justice requires" suspension of 37 CFR 1.97(d). See Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers). Circumstances resulting from applicant's, or applicant's counsel's, failure to exercise due care or to properly apply the patent statutes or rules of practice are not extraordinary circumstances where the interests of justice require the granting of relief. See In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pat. 1990).

Nevertheless, applicant has a suitable remedy on hand for his predicament that does not require the extraordinary remedy of invoking 37 CFR 1.183. Applicant is reminded that the Office will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). As set forth in Section 609(III)(B)(3) of the Manual of Patent Examining Procedure, an

applicant wishing to have the Office consider an IDS, where, as apparently herein, the necessary statement cannot be made, an applicant may file an RCE under 37 CFR 1.114, or a continuing application under 37 CFR 1.53(b), to have the information considered by the examiner.

In view of the above, the petition is dismissed. The IDS filed February 28, 2005, has been placed in the application file but will not be considered by the Office. See MPEP 609. The Office will not waive the requirements of 37 CFR 1.97(d).

The application file is being forwarded to Technology Center Art Unit 2636.

Telephone inquiries relevant to this decision may be addressed to the undersigned at (571) 272-3211.

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